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EXAMINER

STONER, KILEY SHAWN

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,576

Applicant(s)

AOTA ET AL.

Examiner

Kiley Stoner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 08/820,231  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

The terminal disclaimer filed on 3-22-05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/600,611 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant is claiming: a backing plate and a vehicle which were not originally claimed in 08/820,231, yet this application is somehow a divisional of 08/820,231.

The "backing plate" limitation is not present in the original application.

The term "vehicle" is broader than the railway car that the applicant has support for in 08/820,231. So, the term "vehicle" is considered new matter.

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This subject matter is not described in the specification. This subject matter is also not found in the parent application 08/820,231 including the originally filed claims. If the applicant attempts to put these limitations in the instant application, the examiner will have to make a new matter rejection unless the applicant is able to convince the examiner that the claimed subject matter has been previously disclosed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Midling et al. (WO 95/26254). Midling et al. teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures 5a-5e). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most ascetically

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pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (5,460,317) of the IDS. Thomas et al. teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures). A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter it becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

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Claim 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The 2<sup>nd</sup> International Forum of Aluminum Ships of the IDS. The International Forum teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figure 4); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate, a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figure 4 and the title).

A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most ascetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

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Claim 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welding & Metal Fabrication of the IDS. Welding & Metal Fabrication teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figure 1); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate, a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figure 1 and page 4, column 1).

A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bulletin 6 of the IDS. Bulletin 6 teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures 3-4 and page 3, column 3); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate, a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figures 3-4 and page 3, column 3).

A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Childress (5,862,975). Childress teaches a structure body comprising: a first plate and a second



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plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding (Figure 2), a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures 1-2; column 1, lines 13-18; column 2, lines 39-51 and claim 2); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate (Figure 2), a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figures 1-2; column 1, lines 13-18; column 2, lines 39-51 and claim 2).

A friction stir weld will have the same strength whether it is facing toward or away from something. When orientation does not matter is becomes obvious to one of ordinary skill in the art to have the most aesthetically pleasing surface facing towards a direction in which it is going to be viewed. That's why you don't see welds on the outside of automobiles.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection. The 102 rejection of claims 7-8 has been changed to an obvious type 103 rejection.

The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article. The applicant has failed to establish a frame of reference for the outer face. Outer with respect to what portion of the body?

The applicant argues that the phrase "outer face" has a definite meaning in the art, as being opposite an inner face and, e.g., being exposed to the outside, and it is respectfully submitted that the outer face does structurally limit the article. If you have a structural body sitting upright from the ground and is not connected to anything, how can you determine what side is the outer face, at least until it is assembled or connected to something? This proves that outer face is relative until a reference frame is determined for the outer face.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiley Stoner whose telephone number is (571) 272-1183. The examiner can normally be reached on Monday-Thursday (7:30 a.m. to 6:00 p.m.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on Monday-Friday at (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**KILEY S. STONER**  
**PRIMARY EXAMINER**

*Kiley Stoner* 7/30/05